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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,270	05/02/2006	James A. Baum	38-21(52806)B	4307
27161	7590	11/13/2007		
MONSANTO COMPANY 800 N. LINDBERGH BLVD. ATTENTION: GAIL P. WUELLNER, IP PARALEGAL, (E2NA) ST. LOUIS, MO 63167			EXAMINER KUBELIK, ANNE R	
			ART UNIT 1638	PAPER NUMBER
			MAIL DATE 11/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/563,270

Applicant(s)

BAUM ET AL.

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 16-22, 27, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8, 16-22, 27, 35 and 36 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:2.

Group II, claim(s) 1-8, 21-22, 27 and 35-36, drawn to a polynucleotide of SEQ ID NO:3, and host cells comprising it.

Group III, claim(s) 1-8, 21-22, 27 and 35-36, drawn to a polynucleotide of SEQ ID NO:5, and host cells comprising it.

Group IV, claim(s) 1-8, 21-22, 27 and 35-36, drawn to a polynucleotide of SEQ ID NO:7, and host cells comprising it.

Group V, claim(s) 1-8, 21-22, 27 and 35-36, drawn to a polynucleotide of SEQ ID NO:9, and host cells comprising it.

Group VI, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:11.

Group VII, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:12.

Group VIII, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:15.

Group IX, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:16.

Group X, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:17.

Group XI, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:18.

Group XII, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:19.

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Group XIII, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:20.

Group XIV, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:21.

Group XV, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:22.

Group XVI, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:23.

Group XVII, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:24.

Group XVIII, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:25.

Group XIX, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:26.

Group XX, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:27.

Group XXI, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:28.

Group XXII, claim(s) 1-4 and 22, drawn to a polynucleotide of SEQ ID NO:29.

Group XXIII, claim(s) 1-4, 6-8, 21-22, 27 and 35-36, drawn to a polynucleotide of SEQ ID NO:30 and host cells comprising it.

Group XXIV, claim(s) 1-8, 21-22, 27 and 35-36, drawn to a polynucleotide of SEQ ID NO:32, and host cells comprising it.

Group XXV, claim(s) 16-20, drawn to a method for detecting a nucleotide sequence that hybridizes to SEQ ID NO:1.

Group XXVI, claim(s) 16-20, drawn to a method for detecting a nucleotide sequence that hybridizes to SEQ ID NO:3.

Group XXVII, claim(s) 16-20, drawn to a method for detecting a nucleotide sequence that hybridizes to SEQ ID NO:5.

Group XXVIII, claim(s) 16-20, drawn to a method for detecting a nucleotide sequence that hybridizes to SEQ ID NO:7.

Group XXIX, claim(s) 16-20, drawn to a method for detecting a nucleotide sequence that hybridizes to SEQ ID NO:9.

Group XXX, claim(s) 16-20, drawn to a method for detecting a nucleotide sequence that hybridizes to SEQ ID NO:11.

Group XXXI, claim(s) 16-20, drawn to a method for detecting a nucleotide sequence that hybridizes to SEQ ID NO:30.

Group XXXII, claim(s) 16-20, drawn to a method for detecting a nucleotide sequence that hybridizes to SEQ ID NO:32.

2. The inventions listed as Groups I- XXXII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking Groups I- XXXII appears to be tIC insecticidal proteins from *Bacillus thuringiensis*.

However, MONSANTO TECHNOLOGY, LLC (WO 01/87940, cited in the search report) teach the tIC insecticidal protein tIC851 and a nucleic acid encoding it (pg 27, line 14, to 28, line 4; pg 65, line 21, to pg 67, line 8). This nucleic acid would hybridize to at least one of SEQ ID NOs:2, 3, 5, 7, 9, 11, 12, 15-30 or 32 under "specific hybridization conditions", which the instant specification defines as conditions that enable identification of distantly related sequences (pg 21, lines 10-15). Thus, claim 1 among others, is not novel.

Therefore, the technical feature linking Groups I- XXXII is not special and the Groups are not so linked under PCT Rule 13.1.

Applicant is reminded that a determination regarding unity of invention is made without regard to whether a group of inventions is claimed in separate claims or as alternatives within a single claim (MPEP 1893(d), last paragraph).

**3. Applicant is advised that for the reply to this requirement to be complete, it must include (i) an election of an invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out the supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be present at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of the right petition under 37 CFR 1.144.

Should Applicant traverse on the ground that the inventions are not patently distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a refection under 35 U.S.C. 103(a) of the other invention(s).

If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Effective November 1, 2007, if applicant wishes to present more than 5 independent claims or more than 25 total claims in an application, applicant will be required to file an examination support document (ESD) in compliance with 37 CFR 1.265 before the first Office action on the merits (hereafter "5/25 claim threshold"). See Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications, 72 Fed. Reg. 46715 (Aug. 21, 2007), 1322 Off. Gaz. Pat. Office 76 (Sept. 11, 2007) (final rule). The changes to 37 CFR 1.75(b) apply to any pending applications in which a first Office action on the merits (FAOM) has not been mailed before November 1, 2007. Withdrawn claims will not be taken into account in determining whether an application exceeds the 5/25 claim threshold. For more information on the final rule, please see <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>.

In response to the restriction requirement set forth in this Office action, applicant is required to file an election responsive to the restriction requirement. Applicant may not file a suggested restriction requirement (SRR) in lieu of an election responsive to the restriction requirement as a reply. A SRR alone will not be considered a *bona-fide* reply to this Office action.

If applicant elects an invention that is drawn to no more than 5 independent claims and no more than 25 total claims, applicant will not be required to file an ESD in compliance with 37 CFR 1.265 that covers each of the elected claims. If the elected invention is drawn to more than 5 independent claims or more than 25 total claims, applicant may file an amendment canceling a number of elected claims so that the elected invention would be drawn to no more than 5 independent claims and no more than 25 total claims.

If the restriction requirement is mailed on or after November 1, 2007, applicant is also required to file an ESD in compliance with 37 CFR 1.265 that covers each of the elected claims, unless the elected invention is drawn to no more than 5 independent claims and no more than 25 total claims taking into account any amendment to the claims. To avoid the abandonment of the application, the ESD (if required) and the election must be filed within **TWO MONTHS** from the mailing date of this Office action. The two-month time period for reply is extendable under 37 CFR 1.136.

If the restriction requirement is mailed before November 1, 2007, the election must be filed within **ONE MONTH** or THIRTY DAYS, whichever is longer, from the mailing date of this Office action. The time period for reply is extendable under 37 CFR 1.136. Furthermore, if the elected invention is drawn to more than 5 independent claims or more than 25 total claims taking into account any amendment to the claims, the Office will notify applicant and provide a

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time period in which applicant is required to file an ESD in compliance with 37 CFR 1.265 covering each of the elected claims or amend the application to contain no more than 5 independent elected claims and no more than 25 total elected claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The central fax number for official correspondence is (571) 273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne Kubelik, Ph.D.  
November 1, 2007

/Anne Kubelik/  
Primary Examiner